



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,515	10/03/2001	Christophe Bonny	20349-501 DIV	2764

30623 7590 11/27/2002

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
----------	--------------

1652

DATE MAILED: 11/27/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,515

Applicant(s)

BONNY, CHRISTOPHE

Examiner

David J. Steadman

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Application Status

Claims 1-24 are pending in the application.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim(s) 1 and 3-21, drawn to a peptide comprising the amino acid sequence of SEQ ID NO:5, a pharmaceutical composition thereof, a chimeric peptide comprising a trafficking sequence of SEQ ID NO:9, SEQ ID NO:10, or SEQ ID NO:8, which is a species of the generic peptide of SEQ ID NO:9, and a JNK inhibitor sequence of SEQ ID NO:1, which is a species of the generic peptide of SEQ ID NO:5, classified in class 514, subclass 2.
 - II. Claim(s) 1-13 and 15-24, drawn to a peptide comprising the amino acid sequence of SEQ ID NO:6, a pharmaceutical composition thereof, a peptide comprising SEQ ID NO:4, which is a species of the generic peptide of SEQ ID NO:6, a chimeric peptide comprising a trafficking sequence of SEQ ID NO:9, SEQ ID NO:10, or SEQ ID NO:8, which is a species of the generic peptide of SEQ ID NO:9, and a JNK inhibitor sequence of SEQ ID NO:4, and a peptide comprising SEQ ID NO:15, which is a combination of SEQ ID NO:8 and SEQ ID NO:4, classified in class 514, subclass 2.
2. The inventions are distinct, each from the other because:
3. The peptides of Groups I and II, particularly SEQ ID NOs:1 and 5 of Group I and SEQ ID NOs:4 and 6 of Group II, are distinct as both have different structures and, where structural identity is required such as for the production of antibodies, the different sequences have different effects.
4. MPEP 803 sets forth two criteria for restricting between patentably distinct inventions – 1) the inventions must be independent or distinct and 2) there must be a serious burden on the examiner. MPEP 803 states, "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in

Art Unit: 1652

the art, or a different field of search as defined in MPEP 808.02". The inventions are distinct as set forth in item 3 above, thus satisfying the first criterion for restriction. The peptides of Groups I and II are structurally distinct and thus require separate sequence searches, thus satisfying the second criterion for restriction. Because the inventions of Groups I and II are distinct for the reasons given above and each of the inventions requires a separate sequence search, restriction for examination purposes is proper.


5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Claims 1, 3-13, and 15-20 will be examined to the extent the claims read on the elected subject matter.

7. It is noted that claim 22 depends from claim 38. There is no claim 38 present in the instant claim set. For purposes of restriction, the claim has been interpreted as depending from claim 18. It is suggested that applicants amend the claim to correct dependency.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Thursday from 6:30 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.
Patent Examiner
Art Unit 1652


REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP 1600
1600